

REMARKS

In the Decision on Appeal, the Board of Patent Appeals and Interferences reversed the Examiner's rejections to claims 1-55 under 35 U.S.C. § 103 and entered a new ground of rejection to claims 1-12 and 39 under 35 U.S.C. § 112. In view of the decision of the Board, Applicant elects to reopen prosecution pursuant to 37 C.F.R. § 41.50(b). Accordingly, Applicant respectfully requests reconsideration of the application in light of amendments set forth above. Applicant has amended claims 1-6, 8, 10, and 11, and believes that all pending claims, as amended, are in condition for allowance.

Claims 1-12 and 39

The Board rejected claims 1-12 and 39 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended independent claim 1 and the claims that depend therefrom and respectfully asserts that the amended claims fully comply with 35 U.S.C. §112.

In entering the new ground of rejection, the Board stated:

Instant claim 1, from which the other claims depend, recites a “processor-less” portable user interface module. Appellant discloses a base computer 14 having a processor 40 (Spec. at 7; Figs. 1 and 3). User interface module 12 may include (Fig. 3) modem 74, wireless receiver 64 and wireless transmitter 62, input device 60, and display primitive decoder 70.

While it is clear that base computer 14, as disclosed, or a μPDA device having a CPU, as disclosed by Kikinis, cannot be considered “processor-less,” the metes and bounds of the negative limitation cannot be ascertained. The user interface module, as disclosed, may contain a modem; modulating and demodulating signals would appear to constitute a processing of the signals. The module’s input device would appear to process input signals. The decoding of display signals by the module’s primitive decoder would appear to be a (primitive) form of processing of the signals.

We thus cannot determine, to a reasonable degree, what may constitute a “processor-less” portable user interface, as set forth in claim 1. The claims fail to pass muster under 35 U.S.C. § 112, second paragraph.

Decision on Appeal, page 5, paragraphs 2-4.

Applicant has amended independent claim 1 to recite “a portable user interface module being detachably coupleable to the portable base computer, *wherein the portable user interface does not comprise a central processing unit (CPU) operable to execute an application program and to produce results therefrom.*” (emphasis added). Applicant respectfully asserts that independent claim 1 and the claims that depend therefrom, as amended, fully comply with 35 U.S.C. §112, second paragraph. Further, Applicants stress that claim 1, as amended, is still patentable over the Kikinis reference in light of the Goodrich reference. As the Examiner will recall, the Kikinis reference clearly discloses a PDA that includes a *Microcontroller CPU*, memory, and a display. *See* Kikinis, Fig. 3. Accordingly, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 112, second paragraph and allowance of claims 1-12 and 39.

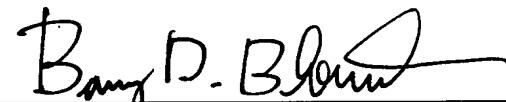
Claims 13-38 and 40-55

In the Decision on Appeal, the Board overruled the Examiner’s rejections under 35 U.S.C. § 103. In particular, the Board stated that the “rejections rely on an improper combination of teachings from Kikinis and Swafford in attempting to meet all the limitations of at least the independent claims.” Decision on Appeal, page 3, lines 13-15. As there are no pending rejections against claims 13-38 and 40-55, Applicant respectfully requests the allowance of these claims.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully request allowance of the pending claims 1-55. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Barry D. Blount
Reg. No. 35,069
(281) 970-4545

Correspondence Address:

Hewlett-Packard Company
IP Administration
Legal Department, M/S 35
P.O. Box 272400
Fort Collins, CO 80527-2400